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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,932	05/15/2001	Tommy F. Brookey	1894-00733	9633

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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/05/2002

Handwritten signature/initials

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

855932

Applicant(s)

BROOKEY

Examiner

P. TUCKER

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9/9/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-21 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-21 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-21 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. According to the declaration filed in serial no. 09/246932, the present invention comprising an aqueous liquid, a viscosifier, a surfactant and aphrons was on sale prior to February 9, 1998. Applicant has not given a specific on-sale date. As such, absent a showing that the invention was not on sale, or in public use, one year prior to the filing date of this application, then the present invention is anticipated. To the extent that a fluid with 11% aphrons was used, claims 5 and 7 are anticipated.

3. Claims 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sebba, Foams and Biliquid Foams - Aphrons, Chapter 5, Pages 63-78, John Wiley & Sons Ltd., Great Britain, (1987).

On page 78, Sebba teaches a composition which comprises sodium alginate which is

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made into a colloidal gas aphron composition. The sodium alginate must also act as a surfactant, or the composition must also comprise a surfactant, in order to form the aphrons. Applicants intended use as a drilling or well servicing fluid does not distinguish over the prior art (In re Pearson 181 USPQ 641).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5 and 7 of U.S. Patent No. 6,148,917.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach the same composition differing only in the intended use of such composition. Case law has held that an intended use cannot patentably distinguish one composition from another (in re Touminen 213 USPQ 89, In re Pearson 181 USPQ 641, In re Zierden 162 USPQ

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102). Furthermore, the variation of the amount of aphrons to achieve optimum viscosity would be an obvious variation to one of ordinary skill in the art.

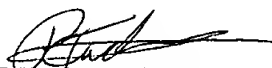
6. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 15-19, 26-28, 30-34, 36-48, 50-57, 71-90 of copending Application No. 09/246932. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims teach a fluid comprising a surfactant, viscosifier and aphrons used in well operations, which would render the present claims obvious to one of ordinary skill in the art over the claims of 09/246932.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Applicants terminal disclaimer has overcome the prior double patenting rejection. New rejections under 35 USC 102, and double patenting rejections are added.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2657
November 27, 2002


PHILIP C. TUCKER
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